

**REMARKS**

The Office Action mailed on April 07, 2003, has been reviewed and the comments of the Patent and Trademark Office have been considered. Prior to this paper, claims 1-18 were pending in the present application. By this paper, Applicants have added claims 19-35. No claims have been deleted. Therefore, claims 1-35 are now pending in the present application.

Applicants respectfully submit that the present application is in condition for allowance for at least the reasons that follow.

**Rejections Under 35 U.S.C. §112, Second Paragraph and §101**

In the Office Action, claim 17 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite, and also under 35 U.S.C. §101. As seen above, claim 17 has been amended, and Applicants respectfully request reconsideration.

**Rejections Under 35 U.S.C. § 102**

Claims 1, 2, 6-7 and 12-18 stand rejected under 35 U.S.C. §102(b) as being anticipated by Tominaga (EP 477,785), and claims 1, 6 and 7 stand rejected under 35 U.S.C. §102(b) as being anticipated by Lesage (USP 5,388,432). In response, Applicants respectfully traverse the rejection for the reasons that follow.

Applicants rely on MPEP § 2131, entitled “Anticipation – Application of 35 U.S.C. 102(a), (b), and (e),” which states that a “claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” It is respectfully submitted that neither Tominaga nor Lesage describe each and every element of claims 1 and 18, the only independent claims prior to the above amendments.

### **The Tominaga Reference**

Claim 1 recites that at least part of the fibers of the fabric are metal and that the fabric has 90 or more stitches per square centimeter. Applicants respectfully submit that Tominaga is completely silent in regard to a teaching of the number of stitches per square centimeter of a fabric. As the Office Action correctly points out, Tominaga does indeed teach the use of a knitting *machine* having a knitting pitch of 10 to 30 gauge. Assuming *arguendo* that the machine of Tominaga is the same as the machine that is recommended in the application for practicing some of the embodiments of the present invention, the Office Action is incorrect in asserting that because of this, the claimed knitted structure would be present in the reference. This is analogous to saying that because Ford recommends utilizing a milling machine having a cutter rotational speed between a set range to manufacture an inventive engine manifold, the manifold would be anticipated because the prior art taught such a mill for machining engine parts. This will be demonstrated below.

The Office Action relies on the teaching of “knitting pitch” in Tominaga because the reference is completely silent in teaching the number of stitches per square centimeter. The term “knitting pitch” refers to the number of needles per inch that are located at the working end of a knitting machine. (See Tominaga, column 3, lines 31-34). That is, all that can be even guessed at from the teaching of a knitting pitch is the number of stitches that can be placed in a row of stitching per a given distance while the fabric is connected to the needles, since, at most, each needle forms a stitch. Indeed, even a rough estimate of the number of stitches cannot be obtained, because there are knitting machines where only the second needle, or only the third needle, etc., is used. However, assuming *arguendo* that each needle is used, the reference fails to teach a stitch density per area of fabric for at least the reason that it does not teach the distance between rows of stitching. Indeed, it does not even teach that the spacing between rows is fixed.

While it is true that Applicants recommend a machine having a gauge of 10 to 32 to practice an embodiment of their invention, such a machine, by itself, does not result in the production of the fabric of Applicants’ invention, as there are other control factors in producing the fabric. In Applicants’ invention, the number of stitches per square centimeter

is related to many factors, such as the thickness of the fibers, the elasticity of the fibers, the selected structure of the knitting, the length of the stitches, the height of the stitches and/or the width of the stitches. Other factors influence the resulting number of stitches per centimeter as well.

In contrast, Tominaga is completely silent in regard teaching the number of stitches per square centimeter of the resulting fabric used by the machine of Tominaga. Thus, it appears that the Office Action is making an inherency argument. However, in view of the content of the Office Action, this is impermissible according to the MPEP, as will be discussed in greater detail below.

### **The Lesage Reference**

As noted above, the Office Action buttressed the rejection of claim 1 with an argument that the claim is anticipated by a second reference, Lesage. As with Tominaga, Lesage simply does not teach the above discussed recitations of claim 1.

The Office Action relies on an example in Lesage where “the distance between the two knitted rows was approximately 1.4 mm.” (Lesage, column 4, lines 25-26.) Recognizing that this alone does not fall under the scope of claim 1, the Office Action goes on to correlate this to a “machine gauge of 18.2 stitches/inch,” then argues that the claim is anticipated because Applicants teach that a knitting machine having a gauge of 16 or more can be used to practice some embodiments of their invention.

In response, Applicants first note that this correlation cannot be made, because the term “row” in the textile arts, and as used by Lesage, refers to a direction that is transverse to the direction of fabric knitting (*across* as opposed to *down*; this is the case with linear algebra matrices as well). The distance between two rows relates only to the height of the stitches, and not the machine gauge, because the machine gauge used to provide the fabric has no direct relation to the height of the stitches. By analogy, to utilize the distance between rows would be like calculating the number of cars which can be parked along a street based on the height of the cars.

Further, the fact that the Office Action again relies on a “machine gauge” value to support an argument of anticipation suggests that, as with Tominaga, the Office Action is making an inherency argument. As with the rejection in view of Tominaga, such an argument is not permitted by the MPEP based on the content of the present Office Action, as will now be discussed.

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Both the Tominaga reference and the Lesage reference are completely silent in regard to a teaching of the number of stitches per square centimeter of a knitted fabric. All that Tominaga teaches is the knitting pitch of a knitting machine. Lesage does not even teach this, but assuming *arguendo* that it did, the only way that the PTO could use these references to anticipate the claimed invention is through an inherency argument.

Applicants respectfully rely on MPEP § 2112, which states that while “a rejection under 35 U.S.C. §102/103 can be made when the prior art product seems to be identical except that the prior art is silent to an inherent characteristic,” the “[E]xaminer *must* provide rationale or evidence tending to show inherency.” (MPEP § 2112, subsections 3 and 4, emphasis added) It is respectfully submitted that no evidence tending to show inherency has been provided in the present Office Action. Further, in considering the examples provided in the Office Action to support an inherency argument, it is respectfully submitted that § 2112 inherency is not being properly implemented. In arriving at this conclusion, Applicants the following excerpt from MPEP § 2112:

The fact that a certain result of characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijkaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that *the missing descriptive matter is necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established

by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.)

(emphasis added) Inherency means that *the missing descriptive matter is necessarily present* in the reference. The courts have allowed the PTO to rely on inherency arguments to free the PTO from the necessity of finding references which explicitly state that inherent elements are present. This is because certain characteristics are inherent, the references will most probably not mention these elements, and, as such, will be difficult to find. For example, it is not necessary to find a reference that explicitly states that plutonium 239 is radioactive, as plutonium 239 is always radioactive. That is, radioactivity is an inherent feature of plutonium 239. However, inherency is not a panacea that enables an examiner to use references which are *deficient* in teaching certain elements of a claim. Recognizing the power of the inherency argument, the courts have tempered its use, as is seen in § 2112, where the PTO has stipulated that an examiner must follow certain procedures before invoking inherency: the “examiner must provide rationale or evidence tending to show inherency.”

In the present case, no such rationale or evidence has been provided in the Office Action. The statements that Tominaga teaches a knitting pitch of 10 to 30 gauge, and therefore, such a knitted structure would be present in the cited references, simply because the Applicants teach that a knitting machine having a gauge falling within the taught range can be used to produce a fabric having 90 stitches per square centimeter, and the similar statements made in reference to Lesage, do not satisfy the PTO’s burden to provide rationale or evidence showing that “the missing descriptive matter is necessarily present.” Just because a prior art machine is similar to another machine that is used to produce a given product with specified properties does not mean that such properties are always present in the product produced by the prior art machine. Just the opposite is true: it is possible that the machines taught in the cited references do not produce a fabric as claimed in claim 1. The subject matter claimed in

claim 1 is not *necessarily present* in the references. It is entirely possible that the references will be practiced without producing a fabric as claimed. Just as was the case of the third fastener in the example provided in the MPEP quoted above, the subject matter of Applicants' claims is not expressly or inherently disclosed in the cited references. Thus, a reference that explicitly teaches these limitations must be found, else the claims must be allowed. Since the references are silent in regard to the additional subject matter claimed in claims 2-18, these claims are allowable as well.

### Claim 3

In the Office Action, Claim 3 is rejected under 35 U.S.C. §102(b) as being anticipated by Tominaga or Lesage, or, in the alternative, as being obvious under 35 U.S.C. §103(a) in view of those same references. Applicants respectfully submit that the rejection is improper as to claim 3, for at least the reasons cited above, and for at least the additional reason that the prior art references do not teach or suggest all the claim limitations of claim 3.

The Office Action admits that the cited references do not “explicitly teach” a fabric having air permeability higher than 2,400 l/cm<sup>2</sup> h. To remedy this, the Office Action relies on an inherency argument, citing *In re Fitzgerald*. However, *In re Fitzgerald*, is discussed at MPEP § 2112, subsection 4, which is entitled “Once A Reference Teaching Product [sic] Appearing to be Substantially Identical is Made the Basis of a Rejection, *and the Examiner Presents Evidence or Reasoning Tending to Show Inherency*, the Burden Shifts to the Applicant to Show an Unobvious Difference” (emphasis added.) However, before subsection 4 of § 2112 can be evoked, the requirements of subsection 3 must be met. It is respectfully submitted that the burden of proof has not yet shifted to the Applicants, because the PTO has not presented evidence or reasoning tending to show inherency, as is required at MPEP § 2112, subsection 3.

Applicants repeat the first sentence of MPEP § 2112, subsection 3, which is:

“the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic,”

and refer the Examiner to the above discussion on inherency, incorporating those statements herein by reference.

In support of its inherency argument, the Office Action simply makes the statement that “it is reasonable to presume that an air permeability higher than 2,400 l/cm<sup>2</sup> h is inherent to Tominaga or Leasage. Support for said presumption is found in the use of like materials . . . which would result in the claimed property.” It is respectfully submitted that this is circular logic, and, thus, the PTO has not met its burden to provide rationale or evidence tending to show inherency. Thus, claim 3 is allowable for this reason as well.

### **New Claims**

As seen above, Applicants have added new claims 19-35. These claims are allowable for at least the reason that they contain the limitations of claim 1, an allowable claim.

### **Conclusion**

Applicants believe that the present application is in condition for allowance, and favorable reconsideration is requested.

If Applicants have not accounted for any fees required by this Amendment, the Commissioner is hereby authorized to charge to Deposit Account No. 19-0741. If Applicants have not accounted for a required extension of time under 37 C.F.R. § 1.136, that extension is requested and the corresponding fee should be charged to our Deposit Account.

Examiner Boyd is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

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